

REMARKS

1. Applicant thanks the Office for its remarks and observations, which have greatly assisted Applicant in responding.

2. **35 U.S.C. § 103**

Claims 1-9, 11 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent no. 6,055,513 ("Katz") in view of U.S. patent no. 7,252,552 ("Franco"). Applicant respectfully disagrees. Applicant incorporates herein its previous remarks regarding Katz as if fully set forth herein.

The Office relies on Katz, Fig. 7:242, col. 18, ll. 2-15 as teaching or suggesting "receive[ing] . . . at least one condition under which the user desires to receive information associated with the product identifier." Applicant respectfully disagrees. The cited teachings describe an upsell transaction wherein Katz's system uses information about a customer to recommend one or more items after the customer makes a primary purchase. The upsell information is not associated in any way with a product identification initially received from the customer. In fact, Katz specifically teaches, at col. 13, ll. 37-40, "The term "upsell" means an offer or provision of a good or service which is selected for offer to the customer and differs from the good or service for which the primary contact was made." Thus, as Applicant has previously argued, the cited teaching from Katz has nothing to do with receiving a condition from a customer under which the user desires to receive information associated with a product identifier that the customer has specified. Katz specifically teaches that an upsell is directed to a good or service other than the one the customer was interested in. Franco adds nothing to Katz. There is, therefore, no teaching or suggestion in the combination of "receive[ing] . . . at least one condition under which the user desires to receive information associated with the product identifier."

The Office relies on Franco, col. 24, ll. 55-67 and col. 25, ll. 1-3 as teaching or suggesting "deliver[ing] the message as to all users where the conditions imposed by the users are satisfied." Applicant respectfully disagrees. Franco teaches, at col. 24, ll. 55-58 that "the order fulfillment allocations are based upon order fulfillment rules that

can be imposed by the Consumer 120, by the merchants participating in the order or both." Accordingly, the cited teaching from Franco is related to order fulfillment for merchandise orders; it has nothing to do with delivering messages according to user-specified conditions. The Office expressly admits that Katz also fails to teach or suggest such subject matter. Accordingly, there is no teaching or suggestion in the combination of "deliver[ing] the message as to all users where the conditions imposed by the users are satisfied."

Because the combination fails to teach or suggest all elements of the Claimed invention, the present rejection is improper. Claim 1 is therefore deemed allowable over the combination.

The foregoing remarks also apply equally to Claims 7 and 8. Claims 7 and 8 are therefore deemed allowable for the same reasons that Claim 1 is allowable.

In view of their dependence from allowable parent Claims, the dependent Claims are deemed allowable without any separate consideration of their merits.

Furthermore, the Office posits that the combination of Katz and Franco would have been obvious to the person of ordinary skill in the art because each of the cited elements from Katz and Franco as combined would have performed the same function as they did separately and, therefore the results of the combination were predictable.

Applicant respectfully disagrees. The above teaching from Franco has to do with order fulfillment for merchandise orders and has nothing to do with delivering messages according to user-specified conditions. Thus, while combining Katz with Franco may have enhanced Katz's merchandise order fulfillment capability, it would have had no effect on Katz's ability to provide information regarding a product identifier, specified by a user, according to conditions specified by a user. Accordingly, it is incorrect that the subject matter of Claims 1, 7 and 8 is a predictable result of the combination of the teachings of Katz and Franco. In fact, the subject matter of the independent Claims is completely unexpected and therefore allowable on this ground alone.

In spite of the foregoing, in order to describe the subject matter of Claim 1 more clearly, Claim 1 is amended to describe "receive, from a user, a product identifier and at least one condition under which the user desires to receive information associated with

the product identifier received from the user." Support for the amendment is implicitly found in Claim 1 because it merely describes explicitly what was already implicitly described. As amended, Claim 1 clearly describes that the condition(s) specified by the user relate to the product identifiers received from the user. As explicitly described by Katz/Franco, upsells have nothing to do with product identifiers received from the user. Claim 7 is amended in the same manner as Claim 1. Accordingly, even if the foregoing rejections of Claims 1 and 7 had not been improper, they would be overcome by the present amendment.

Claim 10 is rejected as being unpatentable over Katz/Franco. In view of the foregoing amendments, the present rejection is deemed overcome.

3. For the record, Applicant respectfully traverses any and all factual assertions in the file that are not supported by documentary evidence. Such include assertions based on findings of inherency, assertions based on official notice, and any other assertions of what is well known or commonly known in the prior art.

4. No new matter is added by way of the foregoing amendments. Such are made only for expediency's sake in recognition of the Office policy of compact prosecution. They do not indicate agreement by Applicant with the Office's position. Nor do they reflect intent to sacrifice claim scope. In fact, Applicant expressly reserves the right to pursue patent protection of a scope it reasonably believes it is entitled to one or more continuing applications.

CONCLUSION

In view of the foregoing, the Application is deemed in allowable condition. Accordingly, Applicant respectfully requests reconsideration and prompt allowance of the claims. Should the Examiner have any questions regarding the Application, she is invited to contact Applicant's attorney at 650-474-8400.

Respectfully submitted,

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